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EXAMINER	
HINES, JANA A	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTINAS KUSLYS, MARIE-CHRISTINE SECRETIN, ROLF JOST, JEAN-CLAUDE MAIRE, OLIVER BALLEVRE, FERDINAND HASCHKE, ZDENEK KRATKY, and NIKLAUS MEISTER

Appeal 2009-014903
Application 10/088,766
Technology Center 1600

Decided: May 24, 2010

Before ERIC GRIMES, LORA M. GREEN, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to infant formula compositions. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

The Specification discloses "a composition for an infant formula which comprises whey protein; casein protein; free arginine; free histidine; and tryptophan rich milk protein, free tryptophan or a mixture thereof" (Spec. 2:15-17). The Specification also discloses that "[p]referably, the whey protein is … sweet whey protein from which caseino-glyco-macropeptide has been removed. This provides the advantage of a reduced threonine content and an increased tryptophan content as compared to normal sweet whey." (*Id.* at 2: 35 to 3: 3.)

Claims 1, 3, 4, 6-10 and 13-20 are on appeal. Claim 1 is representative and reads as follows:

Claim 1: A composition for an infant formula comprising:
whey protein, wherein the whey protein is hydrolysed sweet whey protein from which caseino-glyco-macropeptide has been removed;
casein protein;
free arginine;
free histidine; and
a milk protein comprising 5% or more of tryptophan.

Issue

The Examiner has rejected claims 1, 3, 4, 6-10 and 13-20 under 35 U.S.C. § 103(a) as being obvious in view of Yonekubo[1] and Georgi.[2]

The Examiner finds that Yonekubo discloses infant formula compositions that comprise "natural milk proteins and whey proteins. It is noted that the major components of such milk proteins comprise alpha-lactalbumin, a protein that has a high tryptophan content of approximately 5%" (Ans. 6). The Examiner finds that Georgi discloses reduced-threonine

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[1] Yonekubo, JP-58165742 (Kokai), Sept. 30, 1983.
[2] Georgi et al., US 5,916,621, June 29, 1999.

infant formula containing hydrolyzed sweet whey protein from which glycomacropeptide has been removed (*id.* at 7) and concludes that it would have been obvious to use the modified whey protein taught by Georgi in Yonekubo's infant formula "because Georgi et al., teach that providing infant formula without high threonine levels in the whey protein is advantageous to infants" (*id.* at 8).

Appellants contend that the Examiner erred in finding that the cited references disclose or suggest the claim limitation of "a milk protein comprising 5% or more of tryptophan" (Appeal Br. 11). Appellants argue that "the claimed milk protein is separate and distinct from the whey protein," and therefore alpha-lactalbumin in whey does not meet the claim requirements (Reply Br. 5).

The issue presented is: Does the broadest reasonable interpretation of the claims require "a milk protein comprising 5% or more of tryptophan" as a component separate from whey protein?

Findings of Fact

1. The Specification discloses "a method of producing the composition which comprises the step of blending whey protein and casein protein together with free arginine; free histidine; and tryptophan rich milk protein, free tryptophan or a mixture thereof and homogenising the blended mixture" (Spec. 2: 19-22).

2. The Specification discloses an exemplary infant formula comprising 6-50% whey protein and 0-2% "[a]lpha-lactalbumin rich whey protein source" (Spec. 9: 23-25).

Principles of Law

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt,* 211 F.3d 1367, 1372 (Fed. Cir. 2000).

Analysis

Claim 1 is directed to a composition for an infant formula comprising, among other things, whey protein and a milk protein comprising 5% or more of tryptophan. The Examiner finds that the cited references "teach compositions comprising natural milk proteins, whey powder, nutrients and carbohydrates" (Ans. 9). The Examiner finds that the "whey powder of Yonekubo is a milk protein serum protein" which comprises alpha-lactalbumin, which has a high tryptophan content" of 5% or more (*id.*). The Examiner finds that Yonekubo's whey powder therefore meets the claimed component of "a milk protein comprising 5% or more of tryptophan." (*Id.*). Thus, the Examiner concluded that Yonekubo's teaching of a whey powder met both the "whey" and "milk protein" limitations of the claims.

Appellants respond that alpha-lactalbumin is only present in the whey protein of the prior art compositions and that the "claimed milk protein is separate and distinct from the whey protein. Thus, … the alpha-lactalbumin in the whey protein cannot be a milk protein comprising 5% or more of tryptophan as required … by the present claims" (Reply Br. 5).

Appellants' arguments are persuasive. The claims specify a composition comprising whey protein and a milk protein comprising 5% or more of tryptophan as separately listed components. Consistent with the claims' recitation of these proteins as separate components, the Specification describes a process of making the claimed composition by mixing whey

protein with tryptophan-rich milk protein and exemplifies a composition that comprises both whey protein and an alpha-lactalbumin rich whey protein source.

Claims must not be construed so broadly as to make an express limitation superfluous. *See Texas Instruments, Inc. v. International Trade Comm.*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) ("[T]o construe the claims in the manner suggested by TI would read an express limitation out of the claims. This we will not do."). Thus, the broadest reasonable interpretation of the claims consistent with the Specification requires the claimed composition to contain a milk protein comprising 5% or more of tryptophan separate from the recited whey protein. The Examiner has not adequately explained how the cited references suggest the claimed composition. Thus, the rejection of the claims as obvious in view of Yonekubo and Georgi is reversed.

Conclusion of Law

The broadest reasonable interpretation of the claims requires "a milk protein comprising 5% or more of tryptophan" as a component separate from whey protein, and the Examiner has not shown that the claimed composition would have been obvious based on the cited references.

SUMMARY

We reverse the rejection claims 1, 3, 4, 6-10 and 13-20 under 35 U.S.C. § 103(a).

REVERSED

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